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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,186	09/29/2003	Rudolph Nobis	END-5212	2665

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EXAMINER

KASZTEJNA, MATTHEW JOHN

ART UNIT	PAPER NUMBER
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3739

MAIL DATE	DELIVERY MODE
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05/24/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/674,186

Applicant(s)

NOBIS ET AL.

Examiner

Matthew J. Kasztejna

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3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-20 and 22-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 and 22-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 15, 2007 has been entered.

Notice of Amendment

In response to the amendment filed on March 15, 2007, amended claims 1 and 14-15 are acknowledged. The following new grounds of rejection are set forth:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 10, 14-20 and 22-26 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,830,545 to Bendall.

In regards to claims 10 and 16-20, Bendall discloses a medical device comprising: a flexible member 11; an end effector operatively associated with a distal

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end of the flexible member; and a handle 10 operatively associated with the proximal end of the flexible member; wherein the handle comprises an actuator 20, 22 for operating the end effector through the flexible member; and wherein an outer surface of the handle is sized and shaped to be gripped by a single hand and wherein the actuator is disposed on the handle (see Figs. 1-4 and Col. 2, Lines 15-61). Furthermore, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

In regards to claim 14, Bendall discloses a medical device wherein the handle has a proximal end, a distal end, and an outer surface, the handle outer surface having a maximum width dimension disposed intermediate the proximal and distal ends of the handle (see Figs. 1-4).

In regards to claim 15, Bendall discloses a medical device wherein the actuator comprises a lever adapted to be squeezed between fingers of the same hand and a housing portion of the handle, and wherein the lever is pivotably supported adjacent an end of the handle associated with the flexible member (See Figs. 1-4 and Col. 2, Lines 36-53).

In regards to claims 22-26, Bendall discloses a medical device comprising: a handle 10; an elongate, flexible member 11 extending from the handle, the flexible member having a proximal end and a distal end; and an end effector operatively associated with a distal end of the flexible member; wherein the handle comprises an

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actuator 20, 22 for operating the end effector through the flexible member, and wherein the handle comprises a release 33 or 34 operable by the thumb or index finger of the same hand holding the handle (see Figs. 2-3 and Col. 3, Lines 5-31). The words "for" and "adapted to" in the claims may be properly interpreted as "capable of," and "capable of" does not require that reference actually teach the intended use of the element, but merely that the reference does not make it so it is incapable of performing the intended use.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S.

Patent No. 6,830,545 to Bendall in view of U.S. Patent Application Publication No. 2004/0220449 to Zirps et al.

In regards to claim 11, Bendall discloses a medical device comprising:

a flexible member 11 and an end effector operatively associated with a distal end of the flexible member but is silent with respect to the wherein the end effector is selected from the group consisting of a biopsy forceps, grasping forceps, surgical scissors, extractors, washing pipes, needle injectors, non energized snares, and electrosurgical snares. Zirps et al. teaches of an analogous medical device having an end effector operatively associated with the distal end of a flexible member and wherein the end

effector is a biopsy forceps (see paragraph 0028). It would have been obvious to one skilled in the art at the time the invention was made to associate biopsy forceps with the distal end of the flexible member in the apparatus of Bendall to perform various surgical procedures, treating a desired site within the body as taught by Zirps et al.

Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,830,545 to Bendall in view of U.S. Patent No. 5,624,379 to Ganz et al.

In regards to claim 12-13, Bendall discloses a medical device comprising: a flexible member 11 and an end effector operatively associated with a distal end of the flexible member but are silent with respect to wherein the flexible member is at least one meter long. Ganz et al. teach of an analogous endoscopic instrument wherein the flexible member is at least one meter long. Moreover the length of the elongate member may vary according to its intended application (see Col. 3, Lines 30-35). It would have been obvious to one skilled in the art at the time the invention was made to construct a flexible member in the apparatus of Bendall of a length of at least one meter long to provide access to a variety of desired treatment sites deep within body lumen as taught by Ganz et al. and is well-known in the art.

Response to Arguments

Applicant's arguments with respect to claims 10-20 and 22-26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kasztejna whose telephone number is (571) 272-6086. The examiner can normally be reached on Mon-Fri, 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJK 

5/16/07


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